

REMARKS

Claims 26-30 and 32-52 are pending; claims 39-51 are withdrawn; claims 26-30, 32-38 and 52 are rejected in this application. Claim 32 is amended hereby.

Responsive to the rejection of claim 32 under 35 USC § 112, second paragraph, Applicants have amended claim 32. The amending of claim 32 was undertaken to eliminate indefiniteness noted by the Examiner in the Office Action. For the foregoing reasons, Applicants submit that claim 32 is now in condition for allowance, the allowance of which being hereby respectfully requested.

Responsive to the rejection of claims 26-29, 32-34, and 37 under 35 USC § 103(a) as being unpatentable over International Publication WO 02/103109 (Korhonen) in view of US Patent Application Publication No. 2003/0178165 (Bobsein, et al.), Applicants respectfully traverse the rejection and submit that claims 26-29, 32-34, and 37 are in condition for allowance.

Korhonen discloses a method for the manufacture of LWCR printing paper that is coated once. There is a pre-calender 500, a coating station 600, and a drying section 700 (abstract and page 23, lines 1-11). The LWCR printing paper can be manufactured by film coating method or non-contact coating method. The PPS-s10 roughness of the base paper shall be below 3.5  $\mu\text{m}$  (column 4, lines 1-14).

Bobsein, et al. disclose a paper having an improved print quality and method of making the same including having a sheet gloss, as defined in table 3, of approximately 30% (paragraph 54 and 62).

In contrast, claim 26 as amended, recites in part:

said roughness level and said gloss value in combination having values that lie within a triangularly shaped region defined by a first point, a second point, and a third point, said first point being 0.8  $\mu\text{m}$  roughness level and 3% gloss value, said

second point being 0.8  $\mu\text{m}$  roughness level and 35% gloss value, said third point being 3.9  $\mu\text{m}$  roughness level and 3% gloss value.

(Emphasis added). Applicants submit that such an invention is neither taught, disclosed, nor suggested by Korhonen, Bobsein, et al. or any of the other cited references, alone or in combination, and includes distinct advantages thereof.

Korhonen discloses a method for the manufacture of LWCR printing paper that is coated once and has a PPS-ST roughness below 3.5  $\mu\text{m}$ . Bobsein, et al. disclose a paper having a sheet gloss of approximately 30%. Applicants' claimed invention is a method that specifically results in wood-free coated paper with a combination of quality and roughness that lies within the triangularly shaped range of the independent claim. Applicants' invention surprisingly accomplishes a combination of gloss and roughness that is not obtained by other methods. Furthermore, it is the combination of the two qualities that establish Applicants' method as producing a paper with two desirable qualities in a range accomplished by the steps outlined in the independent claim. The cited prior art does include values for roughness and gloss, but in every case where these values are associated with each other, they lie outside of the area claimed by Applicants. The combination of the cited references does not provide any disclosure where associated roughness and gloss values fall within Applicants' claimed area. This lack of disclosure in the cited references underscores the novelty of Applicants' method. Therefore, Korhonen, Bobsein, et al., and any of the other cited references, alone in combination, fail to teach, disclose, or suggest a roughness level and a gloss value in combination having values that lie within a triangularly shaped region defined by a first point, a second point, and a third point, the first point being 0.8  $\mu\text{m}$  roughness level and 3% gloss value, the second point being 0.8  $\mu\text{m}$

roughness level and 35% gloss value, and the third point being 3.9  $\mu\text{m}$  roughness level and 3% gloss value, as recited in claim 26.

The present invention has several advantages, including the ability to produce paper with a combination roughness and gloss value that is uniquely obtained by the steps of the method utilized by Applicants. For the foregoing reasons, Applicants submit that claim 26, and claims 27-29, 32-34, and 37 depending therefrom, are in condition for allowance, the allowance of which being hereby respectfully requested.

Responsive to the rejection of claims 30, 35, 36, 38 and 52 under 35 USC § 103(a) as being unpatentable over Korhonen, in view of Bobsein, et al. and in further view of US Patent Application Publication No. 2002/0117277 (Johnson, et al.). However, claims 30, 35, 36 and 38 depend from claim 26, which is in condition for allowance for the reasons given above. Accordingly, Applicants submit that claims 30, 35 36, and 38 are in condition for allowance, the allowance of which being hereby respectfully requested. Regarding claim 52, Applicants respectfully traverse the rejection and submit that claim 52 is in condition for allowance.

Johnson et al. disclose a multi-layer printable wear resistant paper (Figs. 1 and 3). Figs. 1 and 3 are both schematic diagrams of a papermaking process (paragraphs 11 and 13).

In contrast, claim 52 recites in part:

drying the paper web by means of at least one device for drying, after the paper web has passed through said at least one device for the application of liquid or pasty application medium in a running direction (L) of the paper web, the paper web is no longer led through any further smoothing or calendering device, and the wood-free coated paper web is produced having a roughness in the range from 0.8-3.9  $\mu\text{m}$  PPS (Parker Print Surf) and a gloss in the range from 3-35% TAPPI 75° (Specular Gloss of Paper and Paperboard at 75°).

(Emphasis added). Applicants submit that such an invention is neither taught, disclosed, nor suggested by Korhonen, Bobsein, et al. or any of the other cited references, alone or in combination, and includes distinct advantages thereover.

Korhonen discloses a method for the manufacture of LWCR printing paper that is coated once and has a PPS-ST roughness below 3.5  $\mu\text{m}$ . Bobsein, et al. disclose a paper having a sheet gloss of approximately 30%. Johnson et al. disclose a multi-layer printable wear resistant paper, with Figs. 1 and 3 both being schematic diagrams of a papermaking process. These figures show the web hanging in midair, which infers that some further processing will follow. These figures and the cited prior art fail to recite the claimed negative limitation. Applicants' claimed invention is a method that specifically excludes the paper web from being led through any further smoothing or calendering device once the paper web has been coated. This is a negative limitation that is discussed in the specification as originally filed and it is used to exclude the prior art as provided for in MPEP 2173.05(i). Full weight of this negative limitation should be given in the evaluation of the claim. The disclosure of this negative limitation is not included in any of the cited references, nor does the combination of the cited references cause the negative limitation to arise. Therefore, Korhonen, Bobsein, et al., Johnson et al. and any of the other cited references, alone in combination, fail to teach, disclose, or suggest the step of drying the paper web by means of at least one device for drying, after the paper web has passed through the at least one device for the application of liquid or pasty application medium in a running direction (L) of the paper web, the paper web is no longer led through any further smoothing or calendering device, and the wood-free coated paper web is produced having a roughness in the range from 0.8-3.9  $\mu\text{m}$  PPS (Parker Print Surf) and a gloss in the range from 3-35% TAPPI 75° (Specular Gloss of Paper and Paperboard at 75°), as recited in claim 52.

The present invention has several advantages, including the ability to produce paper that once coated does not pass through any smoothing or calendering device with the paper then having a combination roughness and gloss value as specified in the claim. For the foregoing reasons, Applicants submit that claim 52 is in condition for allowance, the allowance of which being hereby respectfully requested.

For the foregoing reasons, Applicants submit that the pending claims are definite and do particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Moreover, Applicants submit that no combination of the cited references teaches, discloses or suggests the subject matter of the amended claims. The pending claims are therefore in condition for allowance, and Applicants respectfully request withdrawal of all rejections and allowance of the claims.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorizes that any charges be made to Deposit Account No. 20-0095, TAYLOR IP, PC.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (260) 897-3400.

Respectfully submitted,

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